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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,321	08/27/2003	David Hancock	COMPN-65227	6881

24201 7590 01/29/2007
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EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/650,321	Applicant(s) HANCOCK ET AL.	
	Examiner Thomas C. Barrett	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8,12,13,15,16 and 43-47 is/are pending in the application.
- 4a) Of the above claim(s) 3-5,12,13,16 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6,8,15,43,44 and 46-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 10, 2007 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1, 3-6, 8, 12-13, 15-16, and 43-47 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-6, 8, 12-13, 15-16, and 43-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed

fails to supply support for the limitation wherein the "filament is generally tubular". The specification as filed discloses the filament can be formed or made from a tube, which does not necessarily mean the filament is tubular, or even the broader "generally tubular."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 6, 8, 43-44 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulnev et al. (6,007,574) in view of Leone et al (5,902,266). Pulnev discloses a device (Fig. 1) comprising: an elongate filament configured into a pseudo-braided pattern and formed to define a generally tubular body with a first end and a second end, at least one of the first and second ends having a circumferential dimension; and at least one of said first and second ends each being defined by a

plurality of circumferentially spaced endless reversals of direction of said filament (col. 5, lines 10-29). The embodiment of Fig. 3 has full-turn helical configurations for the reversals. The ends of the filament join in the middle of the device.

However Pulnev et al does not disclose the filament as generally tubular. Leone et al teaches a wire stent whose filament is tubular (e.g. col. 1, lines 10-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of a tubular filament, as taught by Leone et al, to the device as per Pulnev et al., in order to deliver a liquid solution or drug to a stenotic lesion as in Leone et al.

Claims 46, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pulnev et al. (6,007,574) in view of Leone et al (5,902,266) as applied to claim 1 above, in view of Kavteladze et al (5,643,339) as cited in Applicant's IDS. Pulnev et al./Leone et al. discloses a device as above however does not disclose the device as having a variable cross-section, or self-expanding. Kavteladze et al teaches a self-expanding wire stent whose wire can have variable cross-sections (col. 4, lines 55-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of a self-expanding wire stent whose wire can have variable cross-sections, as taught by Kavteladze et al, to the device as per Pulnev et al./Leone et al., in order to be able to adjust the axial stiffness of the device as in Kavteladze et al. In addition, Pulnev et al./Leone et al. discloses the device as made of shape-memory material. It is well known to ones of ordinary skill in the art to use shape-memory material for self-expanding stents, e.g. the stent of Kavteladze et al. In

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addition, though Pulnev et al./Leone et al. fails to disclose reducing the device to less than 10% of its expanded diameter, it would be obvious to one of ordinary skill to make the device as small as possible for easier insertion into the vessel. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. A prima facie case of obviousness based on structural similarity is rebuttable by proof that the claimed compounds possess unexpectedly advantageous or superior properties. Even so, if enough pressure is exerted upon the device of Pulnev et al., it could be made extremely small, and obviously less than 10% of its expanded size.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pulnev et al. (6,007,574) in view of Leone et al (5,902,266) as applied to claim 1 above, in view of Hyodoh et al (20030040772). Pulnev et al./Leone et al. discloses a device as above however does not disclose the device as having a variable cross-section, or self-expanding. Hyodoh et al teaches a wire stent whose wire free ends can be joined in a radiopaque sleeve (paragraph 0166). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teaching of a radiopaque metal sleeve, as taught by Hyodoh et al, to cover the free ends of the wire of the device as per Pulnev et al./Leone et al., in order to reinforce the joining of the ends.

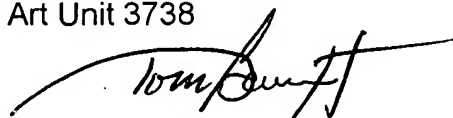
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (571) 272-4746. The examiner can normally be reached on Mon. -Fri. from 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas C. Barrett
Examiner
Art Unit 3738



TOM BARRETT
PRIMARY EXAMINER
TECHNOLOGY CENTER 3700